

REMARKS

Support for claim amendments can be found in the specification at least in paragraphs [0037] – [0047]. Reconsideration and further examination are respectfully requested.

§ 103 Rejections

Claims 1, 3-5, 9, 13, 15, 17-23, 27-29, 31-35, 37-42, 44, 46-47, 49-51, 53-54, 56-57, 61-64, 66, 68-70, 73-80 and 82 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,848,396 (Gerace), in view of U.S. Patent Publication No. 2004/0163101 (Swix), and further in view of U.S. Patent No. 6,934,509 (Shimazu). Claims 2, 10, 45, 48, 52, 60, 65, 67, 71-72 and 81 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gerace in view of Swix, and further in view of The New York Post, Amazon Picks a fight with Old Gray Lady, June 5, 1999, page 17 (NY Post). Claims 6-8 and 14 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gerace in view of Swix, and further in view of U.S. Patent Publication No. 2008/0033870 (Gutierrez). Claims 11, 16, 25, 30, 36 and 43 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gerace in view of Swix, and further in view of U.S. Patent Publication No. 2004/0186776 (Llach). Claim 12 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gerace in view of Swix, and further in view of Official Notice. Claims 58 and 59 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over NY Post, in view of US Patent Publication No. 2003/0204813 (Krause).

Independent claims 1, 23, 29, 35, 41, 64, 73 and 82

Claim 1 recites “determining that the location is in a legal information communication jurisdiction that requires legal information communication to be delivered with documents, the legal information communication associated with trademarks included in the documents.”

The relied upon portions of Gerace describe a home page with a weather category. *Se* Col. 8, lines 52-54. The category provides storm warning for local areas and cities of interest.

See id. at lines 45-58. Upon selection of the weather category, a weather page display object displays weather information. *See id.* at lines 59-61.

The relied upon portions do not teach or suggest any “determining that the locations in a legal information communication jurisdiction **that requires legal information communication to be delivered with document**,” as recited in claim 1. The cited portions also do not teach or suggest any “legal information communication **describing a relationship between trademarks associated with the input and the documents**,” as recited in claim 1. The relied upon portions are merely describing weather alerts.

Swix, Shimazu, NY Post, Gutierrez, Llach, and Krause also do not remedy the deficiencies of Gerace, namely teaching “determining that the location is in a legal information communication jurisdiction that requires legal information communication to be delivered with documents, the legal information communication describing a relationship between trademarks associated with the input and the documents.”

Accordingly, Gerace, Swix, Shimazu, NY Post, Gutierrez, Llach, and Krause, taken alone or in combination, do not teach or suggest each and every element of claim 1 and, therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Claims 2-22 depend from claim 1 and are allowable for at least the same reasons as set forth above with respect to claim 1. Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons.

Claim 23 recites “a processor that determines that the location is in a legal information communication jurisdiction that requires legal information communication to be delivered with documents, the legal information communication describing a relationship between trademarks associated with the input and the documents, the processor receiving a request, and delivering a document in response to the request where delivering the document includes delivering with the document the legal information communication if the location is in the legal information communication jurisdiction.” Claim 23 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 24-28 depend from claim 23 and allowable for at least the same reasons set forth with respect to claim 23.

Claim 29 recites “receiving a request for a document associated with a concept, the document to be provided to a user; identifying a location associated with the request;

determining that the concept is not identified with any trademark recognized by the jurisdiction of the location; and providing a first document associated with the concept ” Claim 29 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 30-34 depend from claim 29 and allowable for at least the same reasons set forth with respect to claim 29.

Claim 35 recites “a server that receives a request for a document associated with a concept, the document to be provided to a user; an identification module that identifies a location associated with the request; a processor that determines that the concept is not identified with any trademark recognized by the jurisdiction of the location; and an output device that provides a first document associated with the concept.” Claim 35 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 36-40 depend from claim 35 and allowable for at least the same reasons set forth with respect to claim 35.

Claim 41 recites “receiving a request for a document associated with a concept; determining whether the concept is identified with a trademark; and delivering the document with a trademark legal information communication based at least in part on whether the concept is identified with a trademark, the trademark legal information communication indicating that the document delivered is not associated with the trademark.” Claim 41 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 42-51 depend from claim 41 and allowable for at least the same reasons set forth with respect to claim 41.

Claim 64 recites “receiving a request related to a concept from a requesting system; identifying one or more documents for possible delivery in response to the request based on the concept; and determining whether to deliver the one or more documents based at least in part on one or more trademark factors and an acceptance level for trademark usage associated with the requesting system .” Gerace is silent on any teaching of “trademark factors” or a “an acceptance level for trademark usage” as recited in claim 64. The Examiner also does not address where in Gerace, or in the other references these features are taught. Claim 64 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 65-72 depend from claim 64 and allowable for at least the same reasons set forth with respect to claim 64.

Claim 73 recites “receiving means for receiving a request related to a concept from a requesting system; identification means for identifying one or more documents for possible

delivery in response to the request based no the concept; and determination means for determining whether to deliver the one or more documents based at least in part on one or more trademark factors and an acceptance level for trademark usage associated with the requesting system.” Gerace is silent on any teaching of “trademark factors” or a “acceptance level for trademark usage” as recited in claim 1. The Examiner also does not address where in Gerace, or in the other references these features are taught. Claim 73 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 74-81 depend from claim 73 and allowable for at least the same reasons set forth with respect to claim 73.

Claim 82 recites “receiving a request related to a concept from a requesting system; identifying one or more documents for possible delivery in response to the request based no the concept; and determining whether to deliver the one or more documents depending on whether a trademark usage rating associated with the one or more documents complies with a trademark acceptance level associated with the receiving system .” Gerace is silent on any teaching of “trademark using rating” or a “trademark accepted level” as recited in claim 1. The Examiner also does not address where in Gerace, or in the other references these features are taught. Therefore, claim 82 is allowable for at least the same reasons set forth above with respect to claim 1.

Independent claims 52 and 58

Claim 52 recites “a server that receives a request to associate a document with a concept; and a processor that determines whether the concept is associated with a trademark, wherein the processor is further configured to deny the request responsive to a determination that the concept is identified with the trademark.” The relied upon portions of Gerace describe a user selecting a weather category and as a result weather notifications being shown on a homepage. *See* Col. 8, lines 52-67. The relied upon portions do not disclose or teach any “concept” much less associating “a document with a concept.” Furthermore, NY Post discloses that the NY Times Co. demanded that Amazon.com stop using its name in promotional materials. NY Post also states that Amazon said it had received a letter from the NY Times saying it was infringing the Times’ copyrights and trademarks. *See* NY Post, page 17.

The Examiner alleges on page 15 of the Office Action that "NY Times teaches online purchases of book which may be searched employing keywords or concepts." The Applicants respectfully assert that no where in the NY Times article does it state the "books ...may be searched employing keywords or concepts," as the Examiner alleges. The Office fails to produce any reference that teaches what they are stating and instead makes use of impermissible hindsight gleaned entirely from Applicants' disclosure. Although, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning" the Office is permitted to use "only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from Applicant's disclosure" (See, MPEP §2145, X, A.)

Accordingly, the relied upon portions of Gerace and NY Post, taken alone or in combination, do not teach or suggest each and every element of claim 52, and therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons. Claims 53-57 depend from claim 52 and are allowable for at least the same reasons set forth above with respect to claim 52.

Claim 58 recites "receiving from an advertiser a request to associate an advertisement with a concept; processing the database to determine whether the concept is associated with a trademark not owned by the advertiser; responsive to a determination that the concept is identified with a trademark not owned by the advertiser, denying the request; and responsive to a determination that the concept is not identified with a trademark not owned by the advertiser, associating the advertisement with the concept." Claim 58 is allowable for at least the same reasons set forth above with respect to claim 52. Claims 59-61 depend from claim 58 and are allowable for at last the same reasons as set forth above with respect to claim 58.

Conclusion

All of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims that have not been expressed. Finally,

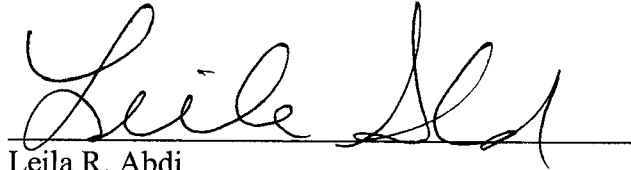
Applicant : Fuloria, et al.
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nothing in this reply should be understood as conceding any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Leila R. Abdi', written over a horizontal line.

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